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IN THE

Supreme Court of the United States

October Term, 1942.

No. **678**

CHARLES P. BOUCHER and BOUCHER INVENTIONS,
LTD., *Petitioners,*

v.

JOSEPH G. SOLA and SOLA ELECTRIC COMPANY,
Respondents.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA.**

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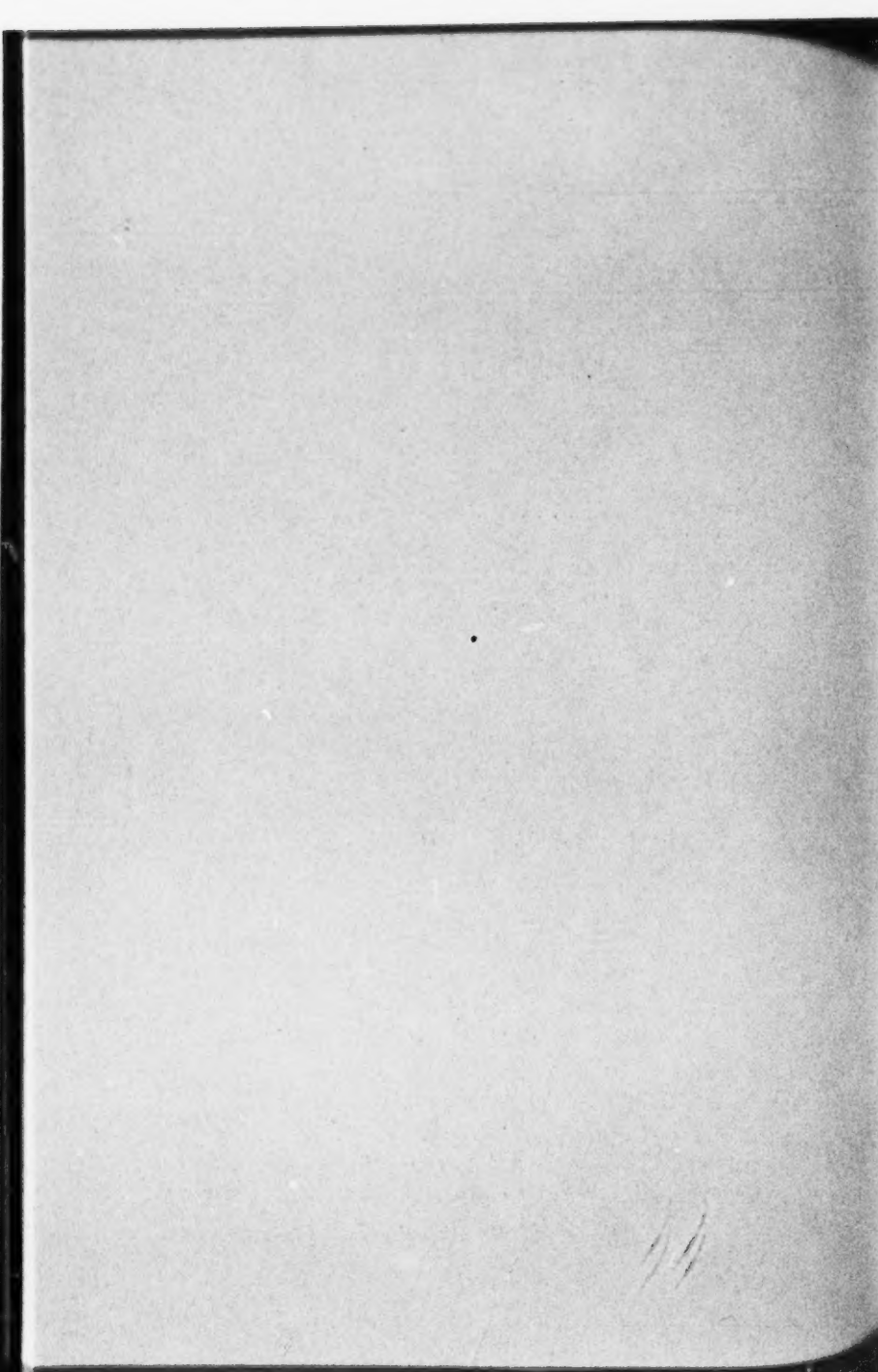


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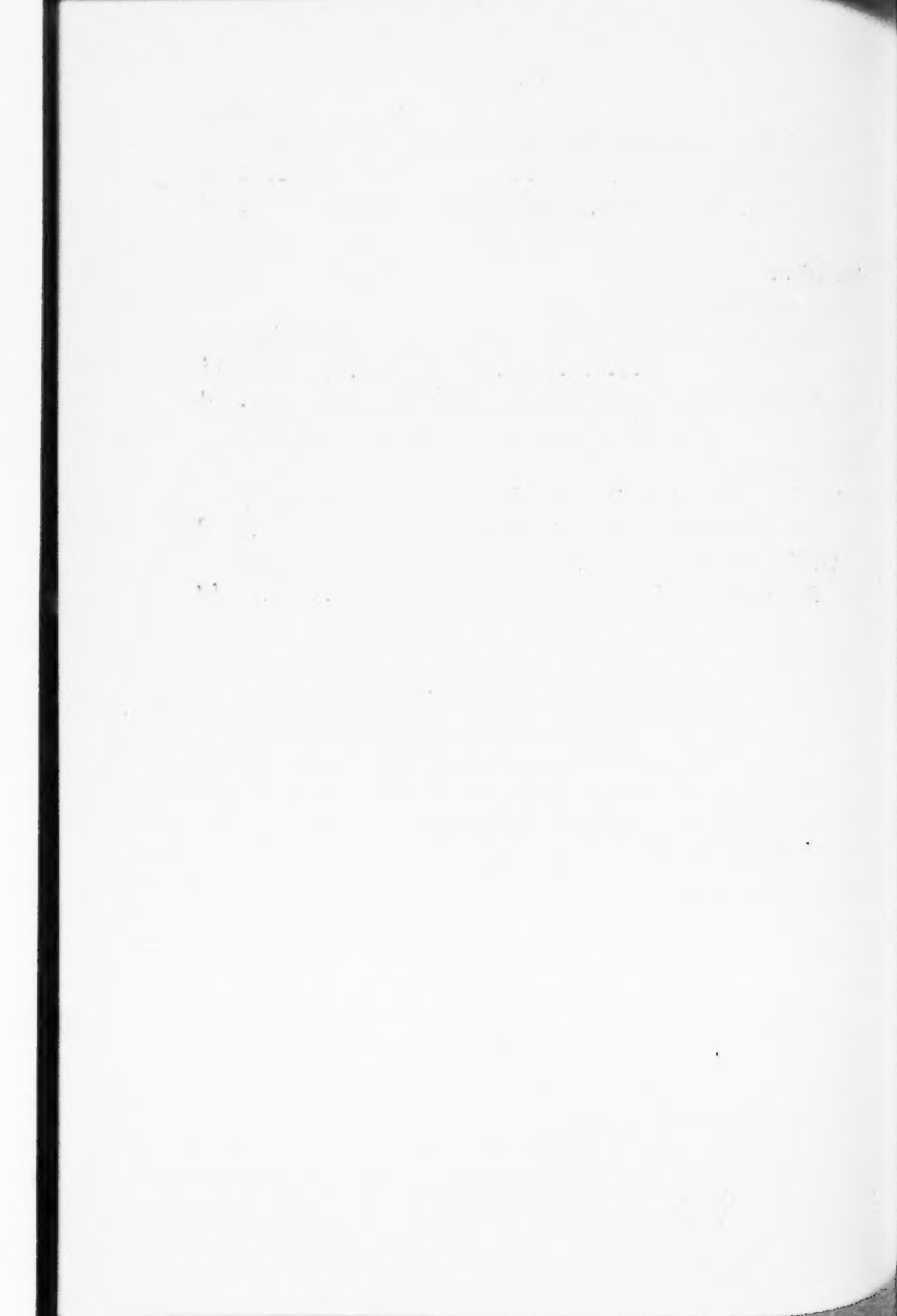
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No.

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PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Charles P. Boucher and Boucher Inventions Ltd., respectfully pray that a writ of certiorari issue out of this Court to review the judgment of the United States Court of Appeals for the District of Columbia entered in the above-entitled cause on June 30, 1942, wherein it erroneously affirmed judgment of the District Court of the United States for the District of Columbia dismissing plaintiffs' complaint.

Opinions of Courts Below.

The decision of the United States Court of Appeals for the District of Columbia, rendered June 30, 1942, is reported in 131 F(2) 225, USPQ 64. The opinion of the United States District Court for the District of Columbia is reported in 35 F. Supp. 504, 48 USPQ 56.

Jurisdiction.

The decision of the Court of Appeals was rendered June 30, 1942, and judgment entered on the same date. A petition for rehearing was filed July 15, 1942. This was denied November 30, 1942.

The jurisdiction of this Court is invoked under the provisions of Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

Questions Presented.

The questions presented are reduced to two in number:

- (1) The United States Court of Appeals, by a two-to-one decision, has unsettled and reversed the law as previously declared and enforced in all of the Federal Courts by holding that: In ascertaining the date when an invention has been completed (reduced to practice) a test made during the litigation reverts back to aid an early, incomplete, cursory and unsatisfactory demonstration, and establish a reduction to practice *nunc pro tunc*, as of the early date.
- (2) The United States Court of Appeals, by a two-to-one decision, has unsettled and reversed the law as previously established in all Federal jurisdictions and has construed Section 4915 of the R. S. contrary to its

obvious intent, and contrary to all previous Federal interpretations thereof, by holding that: Evidence of invention not previously submitted before the Patent Office shall be excluded by the trial court, irrespective of the absence of any showing of a purposeful withholding of that evidence in the Patent Office.

Statute Involved.

Revised Statutes, title LX, section 4915 (U.S.C., title 35, section 63) the pertinent portions of which appear as follows:

“Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts may appear * * * In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.”

Statement.

The present controversy arises from an action to obtain Letters Patent of the United States. It involves the deter-

mination of inventorship between two conflicting parties. The particular subject matter involved is a complicated and improved electrical transformer suited to the operation of neon signs.

On September 20, 1935, Boucher filed in the Patent Office an application for patent describing and claiming the neon sign transformer. Prior to this, on August 27, 1935, defendant Sola had filed a similar application.

An interference was declared by the Patent Office under Section 4904 R. S. making Sola the senior party and Boucher the junior party. Upon evidence submitted, it was held that Boucher had failed to make a prima facie case of reduction to practice prior to the filing date of the Sola application and priority was awarded to Sola on the basis of his earlier filing date. There was no determination by the Patent Office of the actual date of inventorship by Sola or by Boucher.

Following the Patent Office proceeding, an action was brought by your petitioners in the United States District Court for the District of Columbia under the provisions of section 4915 R. S. for the purpose of determining the date of reduction to practice. Additional evidence was submitted by both parties. The court held, upon all of the evidence, that Sola had completed his invention in 1933, a date over two years prior to his filing date and prior to the completion of the invention by Boucher and, accordingly, dismissed the action of your petitioners.

Appeal then was taken to the United States Court of Appeals for the District of Columbia wherein the court, in a two-to-one decision, upheld the lower court in its dismissal of the suit. The majority (Vinson and Rutledge, JJ.) held,

however, that while the tests conducted on the Sola transformer in 1933 may not have been complete, yet further tests conducted on the transformer at the time of the trial in the lower court (1940) related back to the tests in 1933 to establish a reduction to practice (completion of invention) as of 1933.

The dissenting opinion by presiding Justice Stephens follows the established law in all Federal jurisdiction and holds that tests at the time of the trial may not be related back for the purpose of establishing a completion of invention; that the law recognizes no such thing as the reduction to practice *nunc pro tunc*. Mr. Justice Stephens states the established law most ably as follows:

“The majority take the view that the 1933 tests may, however, be validated by considering them in connection with the test made of Exhibit 5 at the time of the trial in 1940 * * * But however successful the test made at the time of the trial may be said to have been, it is in my opinion erroneous to permit this test to apply *nunc pro tunc* so as to validate the insufficient tests of 1933. The question involved in an issue of reduction to practice is not whether an invention would theoretically work but whether it actually did operate successfully.² *Mason v. Hepburn*, 13 App. D. C. 86 (1898); *Hunter v. Strikeman*, 13 App. D. C. 214 (1898); *Paul v. Hess*, 24 App. D. C. 462 (1905); *Gallagher v. Hien*, 25 App. D. C. 77 (1905); *O’Connell v. Schmidt*, 27 App. D. C. 77 (1906); *Wickers v. McKee*, 29 App. D. C. 4 (1907); *Sydeman v. Thoma*, 32 App. D. C. 362 (1909); *Pool v. Dunn*, 34 App. D. C. 132 (1909); *Henderson v. Gilpin*, 39 App. D. C. 428 (1912); *Malcolm v. Richards*, 47 App. D. C. 582 (1918). The following quotation from *Henderson v. Gilpin*, *Supra*, reflects the law expressed in these cases:

“ * * * It is not enough * * * that these * * * tests indicated that the operation of the device would be suc-

² There is an exception not applicable here in the case of very simple machines whose mere construction is accepted by the patent law as a demonstration of workability.

cessful. To constitute reduction to practice, a test must amount to a demonstration in fact, as contradistinguished from one in theory. (39 App. D. C. at 431)' (page 5.)

Moreover, the majority opinion holds that important evidence not produced before the Patent Office may be presumed to have been purposefully suppressed or withheld and may not be admitted in an action under R. S. section 4915. Thus:

"* * * It seems impossible that an exhibit of such importance could have been overlooked or left out by inadvertence * * * While the 4915 suit is *de novo* and permits introduction of evidence not presented to the Patent Office, it does not contemplate the suppression or the withholding of evidence so readily available and of such importance as was Exhibit AR or oversight of such glaring proportions.⁵" (Page 3.)

On this point, Mr. Justice Stephens' dissenting opinion holds that any presumption of a withholding of evidence in the Patent Office proceeding is improper, particularly since such a withholding is unsupported by, and is in fact contrary to, the evidence on this point. Mr. Justice Stephens says:

"I disagree with that part of the majority opinion which implies, although it does not conclusively rule, that the trial court ought not have permitted Boucher to introduce at the trial evidence of the test of Exhibit AR for the reason that such evidence was not introduced in the interference proceeding in the Patent Office. I think this implication of error not supportable. At the trial Boucher explained that the reason he did not introduce this evidence in the Patent Office

⁵ *Greene v. Beidler*, 58 F. (2d) 207, 209 (C. C. A. 2d, 1932) *Barrett Co. v. Koppers Co.*, 22 F. (2d) 395, 397 (C. C. A. 3d, 1927); *O'Donnell v. United Shoe Machinery Corp.*, 2 F. Supp. 178, 181 (D. Mass. 1933); cf. *Perkins v. Lawrence Sperry Aircraft Co.*, 57 F. (2d) 719, 720 (E. D. N. Y. 1932); *Dowling v. Jones*, 67 F. (2d) 537, 538 (C. C. A. 2d, 1933); *Wright v. Runge*, 31 F. Supp. 844 (D. C. 1939).

proceeding was that he did not at that time realize the value of proving in an interference proceeding that his invention had been completely finished and embodied in commercial form. The trial judge apparently accepted this explanation as true. He ruled that in view of the fact that Boucher had not omitted to introduce the evidence in the Patent Office proceeding with an intention of concealment the evidence was properly admissible at the trial. The judge relied upon a former decision of his own in *Wright v. Runge*, 31 Fed. Supp. 844. I think the judge's ruling was correct. Proceedings under Rev. Stat. §4915 are *de novo*; that is, that section gives the parties a right to introduce evidence other than that which was introduced in the Patent Office proceedings. The cases relied upon by Sola as requiring the exclusion of the evidence in question spring from the case of *Barrett Co. v. Koppers Co.*, 20 F. (2d) 395 (C.C.A. 3d, 1927). In that case the party plaintiff in a §4915 proceeding had refused to allow his witness to testify in the Patent Office to certain matters relevant to an issue of priority. He sought to introduce the testimony of these witnesses on these same matters in the §4915 suit but was forbidden to do so. On appeal that exclusion was sustained. The Circuit Court of Appeals held that, in view of the suppression of the evidence in question in the Patent Office proceeding, to allow its introduction in the §4915 proceeding would be to permit the party offering the evidence to profit by its own "technical wrong-doing." It is evident that the decision was reached upon a theory of estoppel, or of quasi-estoppel, which the court based upon the losing party's intentional wrong-doing * * *. In *Wright v. Runge*, cited above, the trial judge, after pointing out that the plaintiff in that case had not deliberately suppressed evidence, said:

" 'It may well be that the plaintiff might be estopped from offering testimony here that he had suppressed in the Patent Office, but the mere failure to exercise the highest degree of diligence in producing evidence before the Patent Office would not, in my opinion, prevent its introduction here.

" 'While it might have been possible in the instant case for the plaintiff to have procured some of the evidence introduced here before the Patent Office, I do not think

that his failure to do so estopped him from offering it here. There is no showing that the defendant was surprised as to its introduction, nor that he could produce evidence to overcome its effect. (31 F. Supp. at 845)'

I think the decision in *Wright v. Runge* was correct and that we cannot say in the instant case that the trial judge ought not have believed Boucher's explanation of his omission to introduce the evidence in question in the Patent Office proceeding." (pages 6 and 7)

Specification of Errors.

The United States Court of Appeals for the District of Columbia erred:

- (1) In holding that tests made in 1940 many years after the filing of the Sola application for patent (constructive reduction to practice) may be related back to certain insufficient tests made in 1933, over two years prior to his application, to establish an actual reduction to practice as of 1933.
- (2) In holding that evidence not presented by plaintiff in the Patent Office proceeding which was received by the lower court should have been excluded.
- (3) In failing to find that that evidence was admissible and as such established a completion (reduction to practice) of the invention by plaintiff below, Boucher, in advance of the filing date of Sola.
- (4) In not reversing the decision of the United States District Court and remanding the cause for further findings of fact.

Reasons Relied on for Issuing the Writ.

The discretionary power of the court to grant a Writ of Certiorari is invoked upon the following grounds:

- (1) That the opinions of the United States Court of Appeals for the District of Columbia in actions under

R. S. section 4915 are looked to as authority since more actions of that type are disposed of by that court than the courts of all other jurisdictions taken together.

- (2) That the United States Court of Appeals for the District of Columbia, in holding that the tests in 1940 at the time of trial relate back to tests in 1933 to establish a reduction to practice as of 1933 (reduction to practice "*nunc pro tunc*"), has unsettled the well-established law on the subject in all Federal jurisdictions.*
- (3) That the decision complained of has opened the door to abuse, which will validate patents which under previous decisions would be viewed as invalid. Logically, under the instant decision, publications and public uses subsequent to an early imperfect testing of a device but prior to the filing of the ap-

* A device is reduced to practice when its practicability is demonstrated.—*Corona v. Dovon*, 276 U. S. 358; *Paul v. Hess*, 24 App. D. C. 462. Practicability of the physical embodiment is involved.—*Bissell v. Phelps*, 50 App. D. C. 261; *Burson v. Vogel*, 29 App. D. C. 388; *Gallagher v. Hien*, 25 App. D. C. 77; *Sydean v. Thoma*, 32 App. D. C. 362; *Ocupaugh v. Norton*, 25 App. D. C. 90. Test must demonstrate practicability.—*Hunter v. Stikeman*, 13 App. D. C. 214; *Sherwood v. Drewson*, 29 App. D. C. 161; *Gallagher v. Hien*, 25 App. D. C. 77; *Sydean v. Thoma*, 32 App. D. C. 362; *Mason v. Hepburn*, 13 App. D. C. 86; *Robinson v. Thresher*, 28 App. D. C. 22; *Lindemeyer v. Hoffman*, 18 App. D. C. 1; *Daggett v. Kaufman*, 33 App. D. C. 450; *Paul v. Hess*, 24 App. D. C. 462; *O'Connell v. Schmidt*, 27 App. D. C. 77; *Hadley v. Ellis*, 49 App. D. C. 84; *Crabbs v. Wardell*, 57 App. D. C. 241; *Henderson v. Gilpin*, 39 App. D. C. 428; *Miehle v. Scott*, 40 App. D. C. 17; *Barley v. Schuler*, 41 App. D. C. 250; *Jobski v. Johnson*, 47 App. D. C. 230; *Malcom v. Richards*, 47 App. D. C. 582; *Derr v. Gleason*, 49 App. D. C. 69; *Fageol v. Lyon*, 53 App. D. C. 361; *Mock v. Johnson*, 52 App. D. C. 300. Manner of operation during test must be as intended for device.—*Janin v. Curtiss*, 45 App. D. C. 362; *McKenzie v. Cummings*, 24 App. D. C. 137. Date of reduction to practice is when device is adequately demonstrated; the patent law recognizes no such thing as reduction to practice *nunc pro tunc*.—*Derr v. Gleason*, 49 App. D. C. 69; *Miehle v. Scott*, 40 App. D. C. 17; *Reichel v. Dorset*, 49 App. D. C. 198; *Urschel v. Crawford*, 22 C.C.P.A. 727—73 Fed. Rep. (2nd) 510; *Hammers v. Bethenod*, 20 C.C.P.A. 744—61 Fed. Rep. (2nd) 1011; *Payne v. Hurley*, 21 C.C.P.A. 1144—71 Fed. Rep. (2nd) 208.

plication for patent by the testor (which publications and uses heretofore under existing law would defeat the testor's application) would be set at naught by relating the subsequent complete testing to the earlier imperfect testing, as establishing a "reduction to practice," as of the early date.

- (4) That the United States Court of Appeals for the District of Columbia, in holding that the additional evidence of invention submitted by Boucher under the circumstances shown by the evidence should not be received, departs from the specific language of section 4915 R. S. providing for a trial *de novo* and departs from all previous interpretations placed upon that statutory provision by the Federal Courts.**
- (5) That the United States Court of Appeals for the District of Columbia, in suggesting that such further evidence had been wilfully withheld, and inadmissible as such, based its suggestion on speculation and not on the evidence and, in that respect, so far departed from the accepted and usual course of judicial proceedings as to call for the exercise by this court of its power of supervision.

** R. S. section 4915 provides, in part, "In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony."

The courts long have recognized an action under R. S. section 4915, as distinguished from an appeal to the Court of Customs and Patent Appeals, as a trial *de novo* wherein further testimony is admissible. See *Sharp v. Coe* 125 F (2) 185 (App. D. C. 1941); *Paulsen v. Coe*, 119 F (2) 188 (App. D. C. 1941); *American Steel & Wire Co. v. Coe*, 105 F (2) 17 (App. D. C. 1939); *General Talking Pictures v. American Tri-Ergon*, 96 F (2) 800 (CCA 3, 1938); *Globe-Union v. Chicago Telephone*, 103 F (2) 722 (CCA 7, 1939); *Powell v. McNamara*, 74 F (2) 750 (CCA 2, 1935); *Nichols v. Minnesota Mining Co.*, 109 F (2) 162 (CCA 4, 1940); *Walker on Patents*, Deller's Edition, Volume II, page 970 and especially 1942 Supplement.

CONCLUSION.

Counsel respectfully submit that this cause cannot be more forcefully stated or ably briefed than appears in the dissenting opinion of Mr. Justice Stephens which is incorporated by reference.

Since, therefore, the majority opinion of the United States Court of Appeals for the District of Columbia unsettles the law in all jurisdictions for determining date of inventorship, opens the door to uncertainties and abuses excluded by all previous decisions, and unsettles the law interpreting section 4915 R. S. regarding the admissibility of evidence by interpretive legislation contrary to all previous Federal interpretations of this section, it is respectfully submitted that the issues are so far-reaching, disturbing, and so vitally affect national and individual interests, vested and inchoate, as to justify a revision by this Court.

WHEREFORE, it is respectfully submitted that this petition for a Writ of Certiorari should be granted.

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Washington, D. C.
January 16, 1943.